

A restriction to either invention I, consisting of claims 1-12 drawn to a Bearing Current Reduction Assembly, classified in Class 310, subclass 90, or invention II, consisting of claims 13-15, drawn to a Bearing Assembly for a Rotor Shaft, classified in class 384, subclass 476, was imposed. In response, Applicant confirms the election with traverse to prosecute the invention of Group I, claims 1-12.

The requirement for election is traversed because the inventions set out by the claims in Groups I and II are clearly related. Applicant submits that a thorough search and examination of either Group would be relevant to the examination of the other Group and would not be a serious burden on the Examiner. Additionally, requirements for election are not mandatory under 35 U.S.C. 121. Accordingly, reconsideration of the election requirement is requested.

The rejection of Claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Barahia et al. in view of Newberg is respectfully traversed.

Barahia et al. describe an auxiliary bearing assembly comprising a rotor shaft (4), a housing (5), and an auxiliary bearing shaft (3). The housing is substantially radially aligned with the rotor shaft and the auxiliary bearing shaft. The auxiliary bearing assembly is attached to the motor such that the rotor shaft is in electrical and mechanical contact with the auxiliary bearing shaft. Furthermore, Barahia et al. describe the auxiliary bearing assembly as a low resistance path from the rotor shaft through the auxiliary bearing shaft to ground (Col. 3, lines 62-64). Accordingly, the auxiliary bearing assembly is not a charge concentrator.

Newberg describes a bearing retainer structure comprising an endshield (2), a bearing support means in the form of an annular support lip (12), and an annular space (19). More specifically, the annular space is provided to receive an expansible-compressible fastening device (21) which retains the bearing (14) in position to enhance the resistance to torsional, axial, and radial thrusts (Col. 3, lines 44-46).

Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. In addition, it is impermissible to use the claimed invention as an

instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Furthermore, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

Neither Barahia et al. nor Newberg, considered alone or in combination, describe or suggest the claimed combination. Rather, the present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Barahia et al. is cited for its teaching of an auxiliary bearing assembly comprising a rotor shaft, a housing, and an auxiliary bearing shaft, and Newberg is cited for its teaching of a bearing retainer structure comprising an endshield and a bearing support means in the form of an annular support lip. There is no teaching or suggestion in the cited art for the claimed combination, and as such, the Section 103 rejection appears to be solely based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicant requests that the Section 103 rejection of Claims 1-12 be withdrawn.

Furthermore, and to the extent understood, neither Barahia et al. nor Newberg, considered alone or in combination, describe or suggest, the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. Specifically, Claim 1 recites "a bearing current reduction assembly comprising a rotor shaft...and an inner bearing cap substantially radially aligned with said rotor shaft, wherein the inner bearing cap comprises an inner end, said inner end in close proximity to said rotor shaft...and a charge concentrator disposed on at least one of said rotor shaft and said inner end."

Neither Barahia et al. nor Newberg, considered alone or in combination, describe or suggest a bearing current reduction assembly comprising a charge concentrator that is disposed on at least one of the rotor shaft and the inner end. Rather, Barahia et al. and Newberg appear to teach away from the present invention. More specifically, Barahia et al., as understood, describe an auxiliary bearing assembly wherein a low resistance path from the rotor shaft through the auxiliary bearing shaft to

ground is created. Accordingly, the auxiliary bearing assembly is not a charge concentrator. Newberg describes a bearing retainer structure comprising an endshield and an annular support lip.

Furthermore, Applicant submits that it would not have been obvious to alter Barahia et al. in view of Newberg to obtain the claimed invention. More specifically, as described above, Newberg teaches the use of a bearing retainer structure comprising an endshield and an annular support lip, and Barahia et al. teach mechanically engaging and contacting the auxiliary bearing shaft to the rotor shaft to provide a low resistance path to ground, not a charge concentrator. For at least the reasons set forth above, Claim 1 is submitted to be patentable over Barahia et al. in view of Newberg.

Claims 2-6 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2-6 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2-6 likewise are patentable over Barahia et al. in view of Newberg.

Claim 7 recites an electric motor assembly comprising "a motor housing, a stator mounted in said housing and comprising a bore therethrough, a rotor core rotatably mounted in said housing and extending through said stator bore, a rotor shaft extending through said rotor core...at least one endshield...an inner bearing cap radially aligned with said rotor shaft, said inner bearing cap having an inner end and an outer end, said inner end in close proximity to said rotor shaft...and a charge concentrator disposed on at least one of said rotor shaft and said inner end."

Neither Barahia et al. nor Newberg, considered alone or in combination, describe or suggest an electric motor assembly including "a charge concentrator disposed on at least one of the rotor shaft and the inner end." Rather, Barahia et al. and Newberg appear to teach away from the present invention. More specifically, Barahia et al., as understood, describe an auxiliary bearing assembly wherein a low resistance path from the rotor shaft through the auxiliary bearing shaft to ground is created. Accordingly, the auxiliary bearing assembly is not a charge concentrator. Newberg describes a bearing retainer structure comprising an endshield and an annular support lip.

Furthermore, Applicant submits that it would not have been obvious to alter Barahia et al. in view of Newberg to obtain the claimed invention. More specifically, as described above, Newberg teaches the use of a bearing retainer structure comprising an endshield and an annular support lip, and Barahia et al. teach mechanically engaging and contacting the auxiliary bearing shaft to the rotor shaft to

provide a low resistance path to ground, not a charge concentrator. For at least the reasons set forth above, Claim 7 is submitted to be patentable over Barahia et al. in view of Newberg.

Claims 8-12 depend from independent Claim 7. When the recitations of Claims 8-12 are considered in combination with the recitations of Claim 7, Applicant submits that dependent Claims 8-12 likewise are patentable over Barahia et al. in view of Newberg.

For the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 1-12 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Thomas M. Fisher
Registration No. 47,564
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070